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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,803	07/27/1999	MITSUHIRO KUNIEDA	35.G2440	5976

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NEW YORK, NY 10112

EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/361,803

Applicant(s)

KUNIEDA ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borsenberger *et al.* in US Patent 4,578,334 in view of JP 01-84265, or Kawamorita *et al.* in US Patent 5,202,214, or Kovacs in US Patent 5,373,313.

Borsenberger discloses an electrophotographic photosensitive member having a conductive support, a charge generation layer containing a specific perylene compound (i.e., PPC), and a charge transport layer on the charge generation layer. Exemplified charge transport layers contain a tri-p-tolylamine or a triphenylamine dispersed in a polycarbonate binder (Examples 1 and 2). Borsenberger teaches that the specific perylene used has a sensitivity in the range of from about 400 to about 700 nm (col. 11, l. 62-67) with specific sensitivity in the range of from 420 to 470 nm (col. 12, l. 24). The photosensitive member is exposed to light in the perylene's area of sensitivity in the Examples.

The reference does not specify the transmittance of the charge transport layer at the wavelengths where the member is exposed but the artisan would expect the charge transport layer to have little absorbance (i.e., a large transmittance) in the wavelength of exposure because if the charge transport layer absorbed a large amount of light in the exposure wavelength it would reduce the charge generation effect in the charge generation layer. The charge generation effect is catalyzed by light and the artisan would expect and desire the maximum amount of exposure light to reach the charge generation layer. Consequently, the claimed transmittance is either inherent in Borsenberger or would have been obvious for the reasons given.

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The primary Borsenberger reference does not disclose the process cartridge or the apparatus of the claims, but the Examiner takes Official Notice that the specified structures of the process cartridge and the apparatus, with the exception of the semiconductor laser, are well known in the art. The specific laser sources are well known in the art as seen in the supporting references (i.e., JP, Kawamorita, and Kovacs). See the Office action of 5 June 2003, pp. 5-7, which is incorporated here by reference. This laser source is effective for exposing a photosensitive member to light in the wavelengths where the photosensitive member of Borsenberger is sensitive (e.g., JP reference: 400 to 600 nm).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the photosensitive member of Borsenberger in an apparatus or a process cartridge having the specified structure of the instant claims because the basic structure of the process cartridge and apparatus is exceedingly well known in the art and placing the photosensitive member in a process cartridge or an imaging apparatus would permit the artisan to reproduce images quickly, as is common in home and office settings. The use of a semiconductor laser as the exposure source for Borsenberger's photosensitive member would have been obvious because this exposure source is taught by the secondary references as effective in electrophotographic image copying processes, which are used by the primary reference. Matching of the exposure source and peak absorption of the perylene would have been obvious in order to optimize the charge generation effect.

Applicants' remarks have been considered but are moot in view of this new ground of rejection.

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The previously applied grounds of rejection are overcome by applicants' amendments.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHRISTOPHER RODEE  
PRIMARY EXAMINER

cdr  
2 November 2004